



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,865	12/31/2003	Sven Schwerin-Wenzel	103580.00020	6320
54975	7590	09/30/2009		
HOLLAND & KNIGHT LLP 10 ST. JAMES AVENUE BOSTON, MA 02116-3889				
EXAMINER				
LONG, PONYA M				
ART UNIT		PAPER NUMBER		
3689				
MAIL DATE		DELIVERY MODE		
09/30/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/749,865

Applicant(s)

SCHWERIN-WENZEL ET AL.

Examiner

FONYA LONG

Art Unit

3689

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 21-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 21-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This communication is a Final Office Action rejection on the merits in response to communication received on May 26, 2009. Claims 1, 23-26, 28, and 32-35 have been amended. Claims 3-20 have been cancelled. Claims 1, 2, and 21-36 are currently pending and have been addressed below.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, 2, and 21-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As clarified in *Bilski*, the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

As per Claims 1, 2, and 21-27, the claim limitations recite "providing" a first and second interface on a computer display; and providing one or more tools. However, the claims fail to recite a particular machine or apparatus being used to perform method steps. The claims simply recite what the interfaces and tools are adapted to do. While applicant states in the preamble that the invention is a method for planning a merger, all applicant does is provide or make available a GUI. The claims also fail to recite a transformation of a particular article into a different state or thing. The claims are directed to data gathering and distribution.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 21, 23, 24-27, 28-30, and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marpe et al. (6,671,692) in view of Okura (5,829,003).

As per Claims 1 and 28, Marpe et al. discloses a method and article comprising:

providing, in a graphical user interface on a computer display, a first interface for a first organization adapted to plan a project with a resource management capability and a time management capability (Col. 18, Line 25-Col. 20, Line 6, discloses an

"Executive Dashboard" interface that allows users to plan milestones according to time and resources);

providing, in a graphical user interface on the computer display, a second interface for a second organization adapted to provide collaborative capabilities to plan the project with said resource management and said time management, said first and second interfaces forming a collaborative workspace between said first organization and said second organization (Col. 33, Lines 37-57, discloses a "Decision Management Tool" allowing users to collaboratively plan and make decisions regarding a merger project); and

providing one or more tools graphically displayed on at least one of said interfaces adapted to exchange merger information and aid in collaboration with said plurality of said organizational members (Col. 47, Lines 50-64, discloses an "M&A Planning Guide" which allows its users both client and [internal] personnel and other interested users to share and exchange information via "an interactive web-based tool");

wherein said one or more tools provide one or more graphically displayed features including:

a feature for defining one or more milestones; a feature for choosing one or more resources to assign to one or more tasks or said one or more milestones; a features for selecting when said one or more tacks is schedules for completion; and a feature for detecting and displaying interdependencies between tasks (Col. 18, Lines 35-48, discloses determining (i.e. defining) a plurality of milestones associated with the merger or acquisition).

However, Marpe et al. fails to explicitly disclose an organizational structure tool and an employee redeployment tool.

Okura discloses a method and apparatus for forming and managing an organization chart with the concept of an organizational structure tool including a feature for hierarchically displaying departments of said at least two organizations (Col. 8, Lines 11-16, via the organization section is a kind of hierarchical chart), a feature for displaying positions of said at least two organizations (Fig. 3A & 3B; Col. 2, Line 59-Col. 3, Line 16, discloses an organization chart which hierarchically expresses the organizations and explicitly indicates a specific organizations to which each organization constituent member belongs), and a feature for employee reassignments between said at least two organizations (Abstract, via user designating "move" (i.e. reassignment) or the like to an employee or a department section on the organization chart through an input unit, an organization chart editing processing program executes this designation and changes the organization chart); and

an employee redeployment tool for redeploying employees of the at least two organizations, the employee redeployment tool including a list of said position of said at least two organizations, a new position request function for creating a new position, one or more fields providing a position details of each position in the list of positions, and employees associated with each position (Fig. 12 & 13; Col. 20, Line 57-Col. 21, Line 13, discloses a department/section table that contains information associated with department/sections of an organization which includes the name of department/section and an employee number representing an employee as the department/section

manager. The apparatus also contain an employee master file for storing various information associated with an employee of a department/section in association with the department/section code which includes a post (i.e. employee's position). Abstract, discloses a user designating (i.e. requesting) "move" or the like to an employee (i.e. move a employee to a different position) on the organization chart through an input unit, and organization chart editing processing program executes this designation and changes the organization chart).

Therefore, from the teaching of Okura, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system for facilitating the navigation of data of Marpe et al. to include an organizational structure tool and an employee redeployment tool in order to aid analyzing the structure of the organizations such as number of departments and positions in order to determine departmental and employee position requirements when performing a merger.

As per Claims 2 and 29, Marpe et al. discloses wherein at least one of said first interface and second interface further comprises:

a communication interface (Col. 33, Lines 37-57, via Decision Management Tool wherein information is communicated among the users via a bulletin board accessible via the network);

an information sessions interface (Col. 18, Lines 25-48, via Executive Dashboard which provides summary of data relating to a merger via an interface to a database. A plurality of issues relating to a merger are identified; and a plurality of milestones associated with the merger are determined in operation); and

one or more interface for a manager to communicate merger information with one or more employees (Col. 33, Lines 37-57, via Decision Management Tool wherein information is communicated among the users via a bulletin board accessible via the network).

As per Claims 21 and 30, Marpe discloses wherein said merger information further comprises:

progress information regarding said merger (Col. 18, Lines 35-48, via progress of the projects is gauged in terms of a plurality of criterion and the issues, the milestones, and the gauged progress of the projects are outputted in operation);

questions and answers between said employees and said manager (Col. 9, Lines 48-57, via M&A Engine utilizes discussion databases to submit and/or answer issues, questions, and topics); and

communications between said employees and said manager, wherein said interfaces are adapted to allow multiple users to access and view said interfaces (Col. 9, Lines 41-47, via M&A Engine allows merger/acquisition participants to access information and deliverables, contribute knowledge, and conduct informal conversations).

As per Claims 23 and 32, Marpe et al. discloses one or more tools further include a collaboration tool (Col. 9, Line 21-Col. 10, Line 4, discloses M&A being used as a collaboration tool) to create:

chat sessions and other interactive discloses (Col. 14, Line 59-Col. 15, Line 8, via Bulletin Board system that allows users to chat online with other users and send email),

online meetings (Col. 9, Line 58-Col. 10, Line 4, via users are able to conduct "virtual meetings"),

synchronized browsing (Col. 1, Lines 6-9, via browsing data using a data browser),

checklists for financial objectives with deadlines and specific individuals who are responsible for said checklists, and

sub-checklists for related actions (Col. 26, Lines 15-Col. 27, Line 35, via a List of Key Milestones having an individual responsible for the milestones and a deadline (via scheduled end).

As per Claims 24 and 33, Marpe et al. discloses said interfaces are connected to a source system, and said interfaces and said source system communicate with network communication interfaces of a base system using a markup language (Col. 9, Lines 22-40, via M&A Engine is stored on a centralized server which may be accessed over a network. Col. 7, Line 63-Col. 18, Line 19, discloses the invention utilizing HyperText Markup Language (HTML) to implement documents on the Internet together with a general-purpose secure communication protocol for a transport medium between the client and a company).

As per Claims 25 and 34, Marpe et al. discloses said communication interfaces include one or more of enterprise connector interfaces, internet communication

interfaces, an encapsulated postscript interfaces, and interfaces that provide remote function call capability (Col. 15, Lines 9-17, via Bulletin Board system (BBS) allows people to call from their computers and post and receive messages).

As per Claims 26 and 35, Marpe et al. discloses wherein said one or more tools further include a group communication tool for :

arranging meeting (Col. 9, Line 58-Col. 10, Line 5, via conduct "virtual meetings" via the M&A Engine discussion database),

starting discussion threads (Col. 15, Lines 41-56, via a Discussion Database which includes a broad topic field having Discussion Groups relation to specific subject areas), and

personalizing panels for individual tasks, deliverables, and meetings (Col. 15, Lines 18-32, via BBS used for posting messages of a particular group of users who have similar interests).

As per Claims 27 and 36, Marpe et al. discloses providing a search query interface in at least one of said first and second interfaces comprising one or more search fields in the interface that allow a user to enter a search parameter for at least one merger organization, wherein the search parameter comprising an attribute of an activity, a group name, a group alias, a group administrator, a qualification, an interest, and a profile of an individual (Col. 23, Line 41-Col. 24, Line 7, discloses allowing users to search for one or more status reports in the workbench database using a specified search criteria (i.e. search parameter)).

5. Claims 22 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marpe et al. (6,671,692) in view of Okura (5,829,003), as applied to Claims 2 and 29 above, and in further view of Vogt et al. (7,159,178).

Marpe et al. discloses said interfaces further including:

archived question responses (Col. 9, lines 22-57, via M&A Engine providing questions and answers to the question pertaining to a merger. Col. 47, Lines 51-54, discloses a M&A Planning Guide which allows user to review and update answers to submitted questions), and

a menu of various template types and formats (Col. 17, Lines 55-57, via allows users to access templates, create, store, and retrieve documents).

However, the Marpe et al. and Okura combination fails to explicitly disclose interactive polls, questionnaires, and archived polls.

Vogt et al. discloses a browser-enable collaboration system with the concept of interactive polls, questionnaires, and archived polls (Col. 4, Line 42-Col. 5, Line 12; Col. 7, Line 36-Col. 8, Line 16, discloses providing online polls and questionnaires they may be accessed by a plurality of users and providing poll responses to a plurality of users).

Therefore, from the teaching of Vogt et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Marpe et al. and Okura combination to include interactive polls, questionnaires, and archived polls as taught by Vogt et al. in order to gain insight and opinions of individuals in order to achieve specific objectives.

Response to Arguments

6. Applicant's arguments filed May 26, 2009 have been fully considered but they are not persuasive.

With regards to the 101 Rejection, Applicants amendments to the claims are not sufficient to overcome the 101 requirements set forth in Bilski. The claim limitations recite "providing" a first and second interface on a computer display; and providing one or more tools. However, the claims fail to recite a particular machine or apparatus being used to perform method steps. The claims simply recite what the interfaces and tools are adapted to do. As set forth in the preamble, the invention is directed to planning a merger. However, the claim limitations are only directed to providing or making available a GUI. The claims also fail to recite a transformation of a particular article into a different state or thing. The claims are directed to data gathering and distribution.

With regards to the 102 and 103 rejections, Applicant's arguments with respect to claims 1, 2, and 21-36 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FONYA LONG whose telephone number is (571)270-5096. The examiner can normally be reached on Mon-Thurs. 7:30am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. L./
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689